21

MAY 29 1946

CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI

WILLIAM H. DAVIS.
LOUIS BURGESS.

TOPIC INDEX

PAGE

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI 1

PRAYER 2

BRIEF IN SUPPORT OF PETITION FOR REHEARING 4

I. The Decision of the Second Circuit Court of Appeals Construes a Federal Statute, i. e., R. S. 4886 4

II. There is a Clear and Direct Conflict Between the Construction of R. S. 4886 by the Circuit Court of Appeals in this Case and the Interpretation placed Upon that Statute by this Court 7

(a) The "use" or "public use" in the various patent acts which will defeat a patent is a use in or accessible to the public 7

(b) A secret use by the inventor is not a public use under R. S. 4886 10

(c) Mere operation for profit does not make a use that is otherwise secret and private into a public use and R. S. 4886 admits of no distinction in this regard between the inventor and a stranger to the invention 12

III. The Conflict Between this Decision and the Decision of the Court of Customs and Patent Appeals in Stresau v. Ipsen which is Binding on the Patent Office Interferes with the Uniform Administration of the Patent Laws 14

IV. Practical Considerations make it Important and in the Public Interest that this Conflict be Promptly Resolved 17

PAGE

(a) The decision affects the validity of many patents and unless finally determined by this Court will subject numerous inventors and the public to the uncertainty and expense of litigation 17

(b) The decision of the Circuit Court of Appeals places a construction upon R. S. 4886 in derogation of the constitutional mandate to promote the progress of science and useful arts 17

V. The Decision of the Circuit Court of Appeals in this Case is Controlling on the Rights of the Inventor and of the Petitioner and the facts as hereinafter set forth Preclude obtaining a Conflicting Decision in another Circuit 20

Conclusion 21

Affidavit of R. A. Axline 22

A—Preliminary Injunction Issued by Judge Bright ... 26

Appendix 31

Statutes 31

Excerpts from Congressional Records 35

House Bills and Hearings 37

Statutes Cited	Page in Brief	Page in Appendix
Act of Feb. 21, 1793 (1 Stat. 318), Section 1	7	31
Act of July 4, 1836 (5 Stat. 117), Section 6	7, 8	31
Act of Mar. 3, 1839 (5 Stat. 353)	8	32
Act of July 8, 1870 (16 Stat. 198).....	8, 9, 10, 13	32

	Page in Brief	Page in Appendix
Act of 1874	9	33
Act of Mar. 3, 1897 (29 Stat. 692)	9	33
Act of Aug. 5, 1939	10	34
R.S. 4886	5	34
Congressional Globe		
Apr. 14, 1870, p. 2683	8	35
Apr. 21, 1870, pp. 2875-2876	8	35
Apr. 21, 1870, p. 2879	19	36
June 24, 1870, p. 4821	9, 13	36
House Bills		
H. R. 1714 41st Congress 2nd Session	8, 9, 13	37
H. R. 11019 (Kelly Bill)	18	38
Hearings before House Committee on Patents 72 Congress, 1st Session Mar. 30 and 31, 1932 Remarks of Mr. Emery	18	39
Statement of Commissioner of Patents Coe before Temporary National Economic Committee Jan. 16, 1939	18	41
Statement by Dr. Baekeland before Committee on Patents on H. R. 23417, April 26, 1912, p. 29	19	40
Robinson on Patents		
1 Robinson 434	11	

Table of Cases Cited

PAGE

Addison v. Holly Hill Co., 322 U. S. 607, 618 14

Aerovox v. Polymet, 67 F. (2) 860 (CCA 2) 12, 13

Allen v. Blunt, 1 Fed. Cas. 450 (CC D Mass.) 8

Allinson v. Ideal Filter Co., 21 F. (2) 22 (CCA 8) ... 6, 12

Andrews v. Hovey, 123 U. S. 267 8

Andrews v. Hovey 124 U. S. 694 ..... 8, 9

Bates v. Coe, 98 U. S. 31, 46 .....10, 11

Bryce v. Seneca, 140 F. 161, 174 (CC ND W. Va.) 12

Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 94 13

Egbert v. Lippmann, 104 U. S. 333, 336 .....10, 13

Elec. Storage Battery v. Shimadzu, 307 U. S. 5, 20...10, 11, 12, 13

Ellithorp v. Robertson, 8 Fed. Cas. 562, 566 (CC D.C.) 12

Gillman v. Stern, 114 F. (2) 28, 31 (CCA 2) 12, 13, 14

Grasselli Chemical v. Natl. Anilin, 26 F. (2) 305, 309 (CCA 2) 12, 13

Hall v. Macneale, 107 U. S. 90, 97 .....10, 11

Henry v. Providence, 11 Fed. Cas. 1182, 1188 (CC D. R.I.) 7

Hunt v. Howe, 12 Fed. Cas. 918 (CC. D.C.) 12

Jenner v. Bowen, 139 F. 556, 560, 561 (CCA 6) 12

Kendall v. Winsor, 21 How. 322, 329 9

Macbeth-Evans Glass v. Genl. Elec., 246 F. 695 .... 6, 15

Manning v. Cape Ann Isinglass, 108 U. S. 462, 465 .....10, 11, 13

McClurg v. Kingsland, 1 How. 202 8

PAGE

Natl. Tube v. Steel & Tubes, 90 F. (2) 52, 54 (CCA 3) 12

Parks v. Booth, 102 U. S. 96, 105 .....10, 11

Peerless Roll Leaf Co. v. H. Griffin & Sons, 29 F. (2) 646, 648 (CCA 2) 4, 6, 12, 14

Penn. Elec. v. Conroy, 159 F. 943 (CCA 3) 12

Pennock v. Dialogue, 27 U. S. (2 Peters) 1 .....5, 7, 9, 17

Perkins v. Nashua, 2 F. 451 (CC D NH) 12

Pierson v. Eagle, 19 Fed. Cas. 672 (CC D RI).... 8

Pierson v. Elgar, 4 Cranch. C.C. 454 (Fed. Cas. No. 11,157) (CC D. Col.) 7

Reed v. Cutter, 1 Story 597 9

Schrader's Sons v. Wein Sales Corp., 9 F. (2) 306, 307, 308 (CCA 2) 12, 13, 14

Shaw v. Cooper, 32 U. S. 292, 315, 318 ..... 7, 9

Smith Corp. v. Petroleum Iron Works, 73 F. (2) 531, 537 (CCA 6) 12, 18

Smith & Griggs v. Sprague, 123 U. S. 249, 254, 260..10, 11

Stresau v. Ipsen, 77 F. (2) 937 .....2, 15, 16

U. S. v. Stewart, 311 U. S. 60, 63 14

W. R. Co. v. Sova, 106 F. (2) 478 (CCA 6) 12

Woodbridge v. U. S., 263 U. S. 50 11

Worley v. Tobacco Co., 104 U. S. 340, 343 10

Zinsser v. Kremer, 39 F. 111 (CC D NJ) 12

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Metallizing Engineering Co. Inc., hereby respectfully petitions this Court for a rehearing of its petition for writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit filed herein April 10, 1946 and that this Court, upon such rehearing, vacate the order denying certiorari made May 6, 1946 and grant such petition.

We believe that in denying the petition this Court must have overlooked the following points which in the past have always been considered as compelling reasons for assumption of jurisdiction by this Court. These points are:

1. The decision of the Second Circuit Court of Appeals construes a Federal Statute, i. e. R. S. 4886.

2. There is a clear and direct conflict between the construction of this statute by the Circuit Court of Appeals in this case and the interpretation placed upon that statute by this Court.

3. There is also a clear and direct conflict between the decision of the Second Circuit Court of Appeals in the present case and the Court of Customs and Patent Appeals in *Stresau* v. *Ipsen*, 77 F. (2) 937. This conflict is of a particularly serious nature since the latter decision is binding on the Patent Office and will result in the issuance of patents valid under the *Stresau* decision and decisions of this Court but invalid in the Second Circuit under the decision in the present case.

4. There are practical considerations which make it important and in the public interest that this conflict should be promptly resolved.

5. The decision of the Circuit Court of Appeals in this case is controlling on the relative rights of the inventor and petitioner and of respondent who do 98% of the metallizing business, and the facts as hereinafter set forth preclude obtaining a conflicting decision in another circuit.

These points will be developed in the accompanying brief.

Prayer

WHEREFORE petitioner most earnestly moves and prays this Court for rehearing of its said petition for writ of certiorari and that this Court upon such rehearing vacate the order denying certiorari made May 6, 1946 and extend

its supervisory action to this case and, to that end, issue certiorari to the Circuit Court of Appeals for the Second Circuit.

Respectfully submitted,

WILLIAM H. DAVIS,

LOUIS BURGESS.

We hereby certify that this petition is made in good faith and not for purposes of delay.

WILLIAM H. DAVIS,

LOUIS BURGESS.

BRIEF IN SUPPORT OF PETITION FOR REHEARING

I. The decision of the Second Circuit Court of Appeals construes a Federal Statute, i. e., R. S. 4886.

Insofar as the use by the inventor is concerned, the facts are stated in Findings 8-13 (B[1] 949-952; 62 Fed. Supp. 46-47) and are summarized as follows: The inventor was genuinely engaged in a program of testing to ascertain whether his invention could safely be released for general use and while so engaged rebuilt some parts by the application of the patented process as to which his purpose was not predominantly experimental. This work was conducted in secret and the public derived no knowledge of the process from the parts rebuilt. There was no intent to abandon. There is nowhere in the record the slightest intimation of inequitable conduct.

As pointed out in Conclusion 5 (B 978-980; 62 Fed. Supp. 58):

> "* * * While developing his invention it was necessary for him to continue to earn a living in the little two-man machine shop which he had recently acquired."

This indicates clearly that as to these jobs his primary objective was to support his family and himself while continuing the development of his invention.

On these facts and on the authority of *Peerless Roll Leaf Co.* v. *H. Griffin & Sons Co.*, 29 F. (2) 646, 648, in which the Circuit Court of Appeals for the Second Circuit ruled specifically that such a use is not a public use within the meaning of R. S. 4886, the District Court sustained the patent (Conclusions 4 and 5, B 974-980).

The facts were not disturbed by the appellate court and the decision was overruled on the isolated fact that the

[1] Throughout this brief volumes of the record are designated by the letters A, B or C, followed by the page numbers.

inventor had derived a profit from the operation of his process or, as alternatively stated in the decision, had employed it "to gain a competitive advantage" (C 287).

The decision of the Circuit Court of Appeals rests on a doctrine which the court claims to have been established by the decision of this Court in *Pennock* v. *Dialogue*, 2 Peters (27 U. S.) 1:

> "* * * it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly." (C 287).

The decision assumes that this doctrine controls the construction of R. S. 4886:

> "It is true that for the limited period of two years he was allowed to do so, possibly in order to give him time to prepare an application; and even that has been recently cut down by half. * * * Such a *forfeiture* * * * comes from * * * *the fiat of Congress* that it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure." (C 287).[2]

The decision also shows clearly that in arriving at this conclusion the Court held that operation in secret for profit falls within the public use provision of R. S. 4886.[3]

---

[2] Emphasis ours throughout.

[3] "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Thus, in defining the question presented the Court said (C 283):

> "The only question which we find necessary to decide is as to Meduna's *public use* of the patented process more than one year before August 6, 1942."

In support of its decision the Court refers to *Macbeth-Evans* v. *General Electric Co.*, 246 F. 695, stating (C 285):

> "• • • So far, it was not an interpretation of *'prior use' in the statute;* but, beginning on page 702 Judge Warrington seems to have been construing that phrase and to hold that the sales were such use."

Referring to *Allinson* v. *Ideal Filter Co.*, 21 F. (2) 22, the Court said (C 285):

> "• • • We are disposed however to read the latter part—pp. 27 and 28—as holding that the sale of gasoline was a 'prior use' of the machine, nothwithstanding its concealment."

If there were any doubt as to this point, it is completely dispelled by the fact that the Court correlated its ruling (C 287) with the one year provision of R. S. 4886 which relates to public use and further that it specifically overruled (C 287) its decision in *Peerless Roll Leaf* v. *Griffin, ante,* in which it held that such a use is not a public use within R. S. 4886.

II. There is a clear and direct conflict between the construction of R. S. 4886 by the Circuit Court of Appeals in this case and the interpretation placed upon that statute by this Court.

(a) The "use" or "public use" in the various patent acts which will defeat a patent is a use in or accessible to the public.

The Patent Act of February 21, 1793 (1 Stat. 318)[4] prescribed that an invention shall be "not known or used before the application"[5].

This Court, in *Pennock* v. *Dialogue, ante,* and in *Shaw* v. *Cooper,* 32 U. S. 292, 315, 318, characterized the use that would operate under this statute to defeat a patent as a use in public or by the public.

In the Act of July 4, 1836 (5 Stat. 117) which superseded all previous acts relating to patents, the expression "public use" was adopted and applied by Congress to a use by the inventor or discoverer, i.e.:

> Sec. 6—"* * * and not, at the time of his application for a patent, *in public use* or on sale, with his consent or allowance, as the inventor or discoverer; * * *".[6]

This Act permitted no public use of the invention prior to the application for patent and the rule was so harsh[7]

---

[4] Pertinent sections of the Patent Acts herein referred to are reproduced in the Appendix.

[5] App., p. 31.

[6] App., pp. 31-32.

[7] *Henry* v. *Providence,* 11 Fed. Cas., 1182, 1188 (C. C. D. R. I.); *Pierson* v. *Elgar,* 4 Cranch. C. C. 454 (Fed. Cas. No. 11,157, C. C. D. Col.).

that it was supplemented by the Act of March 3, 1839 (5 Stat. 353)[8] which made such a use with the consent of the inventor ineffective to defeat a patent unless more than two years prior to the application therefor. This was subsequently interpreted by this Court to also apply to the inventor's own use and even to a use by strangers to the invention.[9]

While the supplemental Act of 1839 did not contain the words "public use" or "use in public" the courts made it clear that the use contemplated was a use in public.[10]

The co-existing Acts of 1836 and 1839 were superseded by the Act of July 8, 1870 (16 Stat. 198) which recast the patent law in substantially the present form. As stated by Mr. Jenckes, chairman of the House Committee on Patents, in introducing the bill (H.R. 1714) which became this act, the purpose was to enlarge and clarify the provisions of the previous acts.[11] Mr. Myers of the House Patent Committee stated on the same occasion that the law with respect to the meaning of "public use" was intended to remain unchanged.[12]

The Act of 1870 prescribes as a condition to patentability (Section 24):

---

[8] App., p. 32.

[9] *Andrews* v. *Hovey*, 123 U. S. 267; *Andrews* v. *Hovey*, 124 U. S. 694.

[10] *McClurg* v. *Kingsland*, 1 How. 202; *Pierson* v. *Eagle*, 19 Fed. Cas. 672 (C. C. D. R. I.); *Allen* v. *Blunt*, 1 Fed. Cas. 450 (C. C. D. Mass.).

[11] Congressional Globe, April 14, 1870, p. 2683, App., p. 35. Pertinent excerpts of the Congressional records herein referred to are reproduced in the Appendix.

[12] Congressional Globe, April 21, 1870, pp. 2875-2876, App., p. 35.

"* * * not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, * * *."[13]

In 1874, Section 24 of the Act of 1870 became Section 4886 of the Revised Statutes.[14]

Under this statute, the use that will defeat a patent is therefore identical with that of the preceding Acts. The use is however now for the first time defined without reference to the user and any distinction between the patentee and a stranger to the patent was deliberately abolished.[15] The relationship between this and the preceding Acts was comprehensively reviewed by this Court in *Andrews* v. *Hovey,* 124 U. S. 694.

Various decisions are cited on the margin of the original House bill which became the Act of 1870[16] (H. R. 1714)[17] holding the use comprehended by prior statutes to be a *use in or accessible to the public.* The citation of these cases shows that the meaning of the expression "public use" had become fixed and that the integration of this expression into the Act of 1870 carried forward *that* established meaning.

Though the statute was thereafter amended in other respects, the public use provision thereof remained unaltered. By the Act of March 3, 1897[18] its application was

---

[13] App., pp. 32-33.

[14] App., p. 33.

[15] Congressional Globe, June 24, 1870, p. 4821, App., p. 36.

[16] *Kendall* v. *Windsor,* 21 How. 329 (citing and reaffirming *Pennock* v. *Dialogue, supra,* and *Shaw* v. *Cooper, supra*); *Reed* v. *Cutter,* 1 Story 597 (Justice Story citing *Pennock* v. *Dialogue, supra*).

[17] 41st Congress, 2nd Session, App., p. 37.

[18] App., p. 33.

restricted to this country and by the Act of August 5, 1939[19] the statutory period was reduced from two years to one year.[20]

Following the passage of the Act of 1870 this Court has repeatedly reaffirmed the meaning of public use as so incorporated in that statute as a use in public or accessible to the public. Thus in *Manning* v. *Cape Ann Isinglass,* 108 U. S. 462, 465, this Court defined "public use" within the meaning of R.S. 4886 as "a use open to the public." In *Smith & Griggs* v. *Sprague,* 123 U. S. 249, 254 the "public use" of the statute was held to be one "in the view of such part of the public as choose to resort to his (the patentee's)[21] establishment." And in the more recent case of *Electric Storage Battery* v. *Shimadzu,* 307 U. S. 5," the "public use" under the patent act was defined as a "use for profit not purposely hidden." Other decisions of this Court are of the same import: *Bates* v. *Coe,* 98 U. S. 31, 46; *Parks* v. *Booth,* 102 U. S. 96, 105; *Egbert* v. *Lippmann,* 104 U. S. 333, 336; *Worley* v. *Tobacco Co.,* 104 U. S. 340, 343; *Hall* v. *Macneale,* 107 U. S. 90, 97.

(b) A secret use by the inventor is not a public use under R. S. 4886.

This Court in *Bates* v. *Coe* (*ante*) clearly recognized a public use under the statute to be distinct from a secret use and that a secret use does not fall under the public use provisions of R.S. 4886, stating:

> "Inventors may, if they can, keep their inventions secret; and if they do for any length of time, they do not forfeit their right to apply for patent, unless

---

[19] App., p. 34.

[20] For full text of R. S. 4886 as amended in 1939 see App., p. 34.

[21] Parenthesis ours.

another in the meantime has made the invention * * *. Within that rule and subject to that condition, inventors may delay to apply for a patent;" (p. 46)

And again in *Parks* v. *Booth* (*ante*):

"Inventors may, if they can, keep their inventions secret; but if they do not, and suffer the same to go into public use for a period exceeding what is allowed by the patent act, they forfeit their right to a patent. * * * Unless inventors keep their inventions secret they are required to be vigilant in securing patents for their protection; and if they do not, and suffer the same to be in public use or on sale in this country for more than two years before they apply for a patent, they forfeit their right." (p. 105)

To the same effect are *Hall* v. *Macneale*, 107 U. S. 96, 97; *Manning* v. *Cape Ann Isinglass*, 108 U. S. 465; *Smith & Griggs* v. *Sprague*, 123 U. S. 260; *Elec. Storage Battery* v. *Shimadzu*, 307 U. S. 20.

The subsisting force of the above quoted language of *Bates* v. *Coe* and *Parks* v. *Booth* was affirmed by this Court in *Woodbridge* v. *U. S.*, 263 U. S. 50.

The principle is succinctly stated by that great philosopher on patent law, Robinson:

"A use in public is not necessarily a use by the public. It is distinguished not from an individual, but from a secret use. It is *a use which places the invention in such a relation to the public that if they choose to be acquainted with it, they can do so.*" (1 Robinson 434)

The decisions by this Court defining "public use" under the statute as distinct from secret use have been con-

sistently followed by the lower courts: *Jenner* v. *Bowen* (C. C. A. 6), 139 F. 556, 560, 561; *Penn. Elec.* v. *Conroy* (C. C. A. 3), 159 F. 943; *National Tube* v. *Steel & Tubes* (C. C. A. 3), 90 Fed. (2) 52, 54; *Allinson Mfg. Co.* v. *Ideal Filter Co.* (C. C. A. 8), 21 Fed. (2) 22; *Smith Corp.* v. *Petroleum Iron Works* (C. C. A. 6), 73 Fed. (2) 531; *W. R. Company* v. *Sova* (C. C. A. 6), 106 Fed. (2) 478; *Hunt* v. *Howe* (C. C. D. C.), 12 Fed. Cas. 918; *Ellithorp* v. *Robertson* (C. C. D. C.), 8 Fed. Cas. 562, 566; *Perkins* v. *Nashua* (C. C. D. N. H.), 2 F. 451; *Zinsser* v. *Kremer* (C. C. D. N. J.), 39 F. 111; *Bryce* v. *Seneca* (C. C. N. D. W. Va), 140 F. 161, 174.

Even the Circuit Court of Appeals for the Second Circuit has consistently applied this definition until its contrary decision here involved: *Schrader's Sons* v. *Wein Sales Corp.* (C. C. A. 2), 9 F. (2) 306, 307, 308; *Grasselli Chemical Co.* v. *Natl. Anilin* (C. C. A. 2), 26 F. (2) 305, 309; *Peerless Roll Leaf* v. *Griffin* (C. C. A. 2), 29 F. (2) 646; *Aerovox* v. *Polymet* (C. C. A. 2), 67 F. (2) 860; *Gillman* v. *Stern* (C. C. A. 2), 114 F. (2) 28, 31.

(c) Mere operation for profit does not make a use that is otherwise secret and private into a public use and R. S. 4886 admits of no distinction in this regard between the inventor and a stranger to the invention.

This Court in *Electric Storage Battery* v. *Shimadzu*[22] had under consideration a use obviously commercial but did not on that account assume it to be a public use and proceeded to determine the date on which it actually became a public use in accordance with the legal principle hereinbefore discussed. Many of the cases in which this Court considered the question of secret use actually involved operations for profit and this Court at no time

[22] 307 U. S. 5, 11.

indicated that this feature would per se vitiate the secret nature of the use.

The Circuit Court of Appeals concedes in its decision (C 287) *that a use in secret not for profit whether by the inventor or anyone else is not a public use within R.S. 4886.* The Circuit Court of Appeals also concedes that the *secret use* of an invention *for profit by others* than the inventor *is not a public use within R.S. 4886.* That Court alleges a distinction however to exist between the inventor and others, claiming that a secret use for profit by the inventor is a public use under R.S. 4886. This distinction is untenable. The statute defines the use comprehended without reference to the identity of the user as a public use. The statutory definition cannot mean one thing in application to the patentee and another and different thing in application to a stranger to the patent.

The Act of 1870 as originally proposed contained such a distinction[23] but this was deliberately eliminated before passage[24] and this Court as well as the lower courts have since consistently interpreted the statute without any distinction between inventors or others than inventors regarding public use.[25] This Court in the *Shimadzu* case, which involved a use by a stranger to the invention, on the question of public use as distinct from secret use, cited cases involving uses by the patentees themselves.[26]

---

[23] See parts bracketed for deletion in H.R. 1714 App., p. 37.

[24] See remarks of the Chairman of the House Patent Committee, Congressional Globe, June 24, 1870, p. 4821, App. p. 36.

[25] *Manning* v. *Cape Ann Isinglass* (U. S.), *ante; Electric Storage Battery* v. *Shimadzu* (U. S.), *ante; A. Schrader's Sons* v. *Wein Sales Corp.* (C. C. A. 2), *ante; Grasselli Chemical* v. *National* (C. C. A. 2), *ante; Aerovox* v. *Polymet* (C. C. A. 2), *ante; Gillman* v. *Stern* (C. C. A. 2), *ante.*

[26] *Consolidated Fruit Jar. Co.* v. *Wright,* 94 U. S. 92, 94; *Egbert* v. *Lippmann,* 104 U. S. 333, 336.

Surprisingly enough, the Circuit Court of Appeals for the Second Circuit in its decision in *A. Schrader's Son's* v. *Wein Sales Corp., ante,* specifically pointed out that no such distinction exists in the law of patents, and in *Gillman* v. *Stern, ante,* the same Circuit Court repeated this holding, citing the *Schrader's* case and *Peerless Roll Leaf* v. *Griffin* (*ante*). The decision in *Gillman* v. *Stern* involved a secret use by a *stranger to the invention,* whereas the *Schrader's* and *Peerless* cases, therein cited for authority that the use was not a public use, both involved a secret use by *the inventor himself.*

Neither may the words "public use" connote the inverse of their accepted meaning.[27] If words are to have any use and meaning as guides for human conduct, a use that is private and secret is not by any stretch of interpretation a public use.

III. The conflict between this decision and the decision of the Court of Customs & Patent Appeals in *Stresau* v. *Ipsen* which is binding on the patent office interferes with the uniform administration of the patent laws.

Judge Learned Hand writing the decision of the Circuit Court of Appeals in the instant case directs attention to the fact that his decision is in direct conflict with the

---

[27] As stated by Mr. Justice Frankfurter in *Addison* v. *Holly Hill Co.,* 322 U. S. 607, 618: "After all, legislation when not expressed in technical terms is addressed to the common run of men and *is therefore to be understood according to the sense of the thing, as the ordinary man has a right to rely on ordinary words addressed to him.*"

And by Mr. Justice Douglas in *United States* v. *Stewart,* 311 U. S. 60, 63: *"It is likewise true that Congress will be presumed to have used a word in its usual and well-settled sense. Old Colony R. Co.* v. *Commissioner,* 284 U. S. 552; *Deputy* v. *du Pont,* 308 U. S. 488."

case of *Stresau* v. *Ipsen*, 77 F. (2) 937, decided by the Court of Customs & Patent Appeals.

The *Stresau* case involved an interference between rival inventors. Stresau, an employee of the A. O. Smith Co., had first conceived and reduced to practice. His process was used in welding at the plant of the A. O. Smith Co. as early as September, 1926 and was adopted as standard practice early in 1927 from which time it was used regularly and continuously up to the filing of his application in February, 1929. This use was secret in that it was not disclosed to the public and the employees of the Smith Co. were under contract not to divulge any of the secret processes or trade secrets of the company to the public.

The exact question considered by the Court was (p. 943):

> "*Did the conduct of Stresau,* concededly the first inventor in fact, or his assignee, *in secretly using his process as a commercial process, for profit,* during most of the period *from* its reduction to practice in, say, September, *1926, until* the filing of the application in February, *1929,* concealing all knowledge of it and its use from the public, in the manner which has been described, *amount to a forfeiture in law of his right to a patent* * * *?"

The decision of the Circuit Court of Appeals for the Sixth Circuit in *Macbeth-Evans Glass Co.* v. *General Electric, ante,* was carefully reviewed and distinguished on the ground (p. 944):

> "* * * that, from the facts appearing, Macbeth's conduct was of a character which led irresistibly to the conclusion that he had elected to pursue the secret use of his process and had 'repudiated' the right to

> secure protection of the patent laws. * * * Macbeth's intention was overwhelmingly demonstrated by his actions."

The Court concluded that there was no proof that Stresau or his assignee had elected to abandon the legal right to patent and reversed the action of the Patent Office denying him the right to a patent. In so deciding, the Court said (p. 495):

> "We fully appreciate the fact that the ultimate and fundamental purpose of the constitutional provision for the grant of patent, and of all the laws relating thereto, is the public benefit. Paragraph 8, § 8, article 1 of the Constitution is the only one of the grants of power to Congress which may be said to state within itself the reason for the grant, viz., 'To promote the Progress of Science and useful Arts'.
>
> "The *Congress,* however, *never has deemed it proper to fix by statute a time within which, after reduction to practice, an application must be filed,* * * *."

This decision in the *Stresau* case is binding upon the Patent Office and the latter must issue patents on the basis of that decision.[28]

There is thus presented by the decision in this case the extraordinary and intolerable situation that patents, presumptively valid in law, will be issued by the Patent Office on the basis of the *Stresau* case but will be invalidated in the Second Circuit because of the contrary decision by the Court of Appeals for that circuit.

---

[28] Prior to issue patents may be subject to public use charges or proceedings before the Patent Office or the Court of Customs & Patent Appeals to investigate and determine any charge of public use as a bar to the patent.

IV. Practical considerations make it important and in the public interest that this conflict be promptly resolved.

(a) The decision affects the validity of many patents and unless finally determined by this Court will subject numerous inventors and the public to the uncertainty and expense of litigation.

There are in force today over 600,000 patents. These were applied for and obtained under that construction of the public use provision of the patent statute which is contained in the clear language of the statute and in the decisions of this Court. In view of the great number of subsisting patents and the frequency with which questions of "public use" come before the courts the number of patents which were obtained under the formerly accepted interpretation of the "public use" provision of R.S. 4886 and which are placed in jeopardy by the instant decision is substantial. If these patents are invalid this should in justice to conflicting interests be promptly and finally determined and if they are not invalid the owners of these patents should be spared the delay, expense and uncertainty of further litigation to determine that point.

(b) The Decision of the Circuit Court of Appeals places a construction upon R. S. 4886 in derogation of the constitutional mandate to promote the progress of science and useful arts.

In undertaking to spell out of the *Pennock* case the rule that (C 288).

> "it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure"

the Circuit Court of Appeals doubtless assumed that this was a salutary principle which would speed up the time

within which inventions become available to the public thereby accelerating the advance of the arts.

This overlooks the fact that the inventor is already under a powerful compulsion to patent his invention if that is at all possible. Thus, as stated by the Circuit Court of Appeals, 6th Circuit in *A. O. Smith Corp.* v. *Petroleum Iron Works*, 73 F. (2) 531, 537:

> "There is, moreover, in the case of patentable processes, every incentive to dispatch in seeking protection of the patent law. Prior to patenting the inventor not only risks the loss of his secret through inadvertence or breach of confidence, but likewise through independent discovery. During his period of monopoly he incurs no such hazard. We cannot lightly assume delay inimical to self-interest."

This compulsion operates exclusively in the direction of enforcing diligence whereas the arbitrary requirement that inventors must file within a specified time following the completion of their invention will in many cases cause inventors to reject the alternative of patenting the same and rely upon continued secret practice, thereby impoverishing the arts and sciences.[29]

This may occur for example because one embodiment of his invention is complete and capable of practical application but the principle involved is not sufficiently understood to permit application for patent. It may occur be-

---

[29] Hearings before the House Committee on Patents, 72nd Congress, 1st Session, March 30 and 31, 1932; remarks of Mr. Emery representing the Boston Patent Law Association in connection with the Kelly bill to limit inventors to two years before filing applications for patent and remarks of Commissioner Robertson on the same bill, App. pp. 38 to 40; Statement of Commissioner of Patents Coe before the Temporary National Economic Committee, January 16, 1939 (XXI J. P. O. S., pp. 112-113) App., pp. 41 to 42.

cause one embodiment of the invention has been completed to the point of beneficial application but there are other important aspects of the invention which must still be experimentally tested before application for patent can be intelligently prepared. It may occur because the inventor has been unable to obtain financial backing and would himself be unable to maintain the patent against potential infringers. It may occur because the inventor is without funds with which to apply for patent. It may occur as in the present case because even though some embodiment of his invention may be practicable under his personal control, he is still engaged in experiment to determine whether it may safely be released and is confronted with the stark necessity of supporting himself and his family.

In all these situations the effect of the instant decision of the Circuit Court of Appeals will be to force the invention into secret use and deprive society of the benefits flowing from its more general application.[30] Even though it does not enrich the arts or permit the invention to be generally applied, the secret practice of his invention is in many cases entirely feasible to the substantial benefit of the inventor and would unquestionably be resorted to in many cases if the rule which the Circuit Court of Appeals has advanced in this case is followed in the interpretation of the patent statute.[31]

It is thus evident that the construction placed upon R.S. 4886 by the decision of the Circuit Court of Appeals is in derogation of the constitutional mandate to Congress to "promote the progress of science and useful arts."

---

[30] Remarks of Mr. Jenckes, Chairman of the House Patents Committee in introducing the 1870 bill, Congressional Globe April 21, 1870, p. 2879; App., p. 36.

[31] Statement by Dr. Baekeland before the Committee on Patents on H. R. 23417, April 26, 1912, p. 29, App., p. 40.

V. The decision of the Circuit Court of Appeals in this case is controlling on the rights of the inventor and of the petitioner and the facts as hereinafter set forth preclude obtaining a conflicting decision in another circuit.

The real party defendant in this case is the Metallizing Company of America, a co-partnership. It openly controlled and conducted the defense and is therefore in privity with the nominal defendants (B 942; C 86-87).

Shortly after the process of the patent in suit was communicated to the trade by petitioner, the said Metallizing Company of America began promoting the use of the process of the patent in suit by a nationwide campaign inciting the trade to disregard the patent and practice the process (Axline Affidavit, p. 24, Sec. 5).

Since the District Court did not in this case have personal jurisdiction over the persons composing the said Metallizing Company of America, a suit was started by petitioner in the District Court for the Southern District of New York against said Metallizing Company of America and the persons composing the same to restrain their continued infringement of the patent and a preliminary injunction restraining such infringement was issued by Judge Bright in said suit on August 22, 1945 (*post*, p. 26). This preliminary injunction was dissolved by stipulation immediately following the decision of the Court of Appeals in this case.

Metallizing is practiced by thousands of small machine shops distributed over the entire country (Axline affidavit, p. 22, Sec. 1). Said Metallizing Company of America (together with its affiliate, Metallizing Company of America, Inc., a California corporation) and your petitioner herein, are the principal manufacturers and suppliers in the metallizing field. They occupy the field substantially

exclusively. They collectively supply 98% or more of the metallizing equipment in use in this country and are the only concerns in this field with national distribution. They are the only concerns promoting the use of the process of the patent in suit.

The present holding of invalidity of the patent in suit by the Circuit Court of Appeals automatically determines the outcome of the said suit against Metallizing Company of America establishing the right of said Metallizing Company of America to continue its nation wide program of inciting and promoting infringement. A final adjudication in this case will therefore be conclusive of the entire controversy, making it impossible for petitioner to obtain a conflicting decision in any other circuit.

Conclusion

The decision of the Circuit Court of Appeals in this case construes a federal statute, *i. e.*, R.S. 4886. There is a direct conflict between that construction and the construction placed upon that statute by this Court and by the Court of Customs and Patent Appeals. It is important to the public and in the interest of uniform administration of the patent laws that this conflict should be resolved promptly.

The decision of the Circuit Court of Appeals in this case precludes obtaining a conflicting decision in another circuit.

WHEREFORE your petitioner prays this Court to vacate the order of May 6, 1946 denying the petition for certiorari and issue certiorari to the Second Circuit Court of Appeals in this case.

Respectfully submitted,

WILLIAM H. DAVIS.
LOUIS BURGESS.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO INC., *et al.*,

Respondents.

STATE OF NEW YORK }
COUNTY OF QUEENS } ss.:

REA A. AXILINE, being duly sworn, deposes and says:

1. That he is and at all times subsequent to its incorporation has been President of the above named petitioner, Metallizing Engineering Co. Inc. That said petitioner is engaged in the manufacture and sale of equipment for metallizing and in the sale of materials required in metallizing. Metallizing is carried out by thousands of plants and machine shops distributed over the country and is principally occupied in rebuilding machine parts.

2. That in April, 1942 petitioner acquired title to the invention described and claimed in the patent in suit from the inventor John Frank Meduna, who was then conducting a small machine shop in Seattle, Washington. That up to this time it was difficult or impossible for the metallizing industry to rebuild machine parts which were hard (case hardened) or especially tough (certain alloys) which

constituted the majority of the machine parts available for rebuilding. This problem appeared to be solved and eliminated by the process of the patent in suit. Under petitioner's agreement with the inventor the invention was to be made available to the trade through the system of national distribution maintained by petitioner, the inventor taking as his principal compensation therefor a percentage of the gross profits derived from licensing the invention to the trade. The patent in suit issued to petitioner as assignee of said John Frank Meduna on May 25, 1943.

3. That after entering into said contract with the inventor and upon completion of this program of testing to ascertain whether the invention could safely be released for general use, petitioner communicated the existence of the invention to the trade through advertisements in early 1943, making the invention available to the trade for unlimited use with the designated power source at an annual royalty of about $600, which on March 1, 1945 was reduced to about $250.

4. That when the invention of the patent in suit was communicated to the trade by petitioner, it was immediately and favorably accepted and a substantial number of metallizers began the use of the process under license from petitioner. Also metallizers in various areas commenced infringement of the process, for which reason six suits were started by petitioner against infringers in selected areas to restrain such infringement. On investigation it was found that in each case the infringements had been promoted and incited by the Metallizing Company of America, which is in privity with the defendants Kenyon herein and which is also engaged in the sale of equipment and supplies to the metallizing industry. Three such suits were concluded by consent decrees restraining infringement. This case was continued as a test case between your petitioner and said Metallizing Company of America and

two were held in abeyance, pending the outcome of this case.

5. Following the commencement of this suit the said Metallizing Company of America continued to promote and incite infringement of the patent in suit and conducted a nation-wide campaign inciting the trade to disregard the patent and practice the process of the patent in suit. On June 14, 1944 petitioner started suit in the District Court of the United States for the Southern District of New York against said Metallizing Company of America to restrain the unlawful acts of infringement committed by said company and on August 22, 1945 in said suit a preliminary injunction, copy of which is hereto annexed, marked A, was issued restraining such infringement. This injunction was dissolved by stipulation immediately following the decision of the Circuit Court of Appeals in this case.

6. That your petitioner and said Metallizing Company of America (including its affiliate Metallizing Company of America, Inc., a California corporation) are the principal manufacturers and suppliers in the metallizing field. Collectively they occupy the field substantially exclusively. They supply 98% or more of the metallizing equipment in use in this country and are the only concerns in this field with national distribution. They are the only concerns promoting the use of the process of the patent in suit.

7. That since the field of selling metallizing equipment and supplies is substantially exclusively occupied by said Metallizing Company of America and your petitioner, a final decision in this case holding the patent invalid and establishing the right of said Metallizing Company of America to continue its nation-wide program of inciting and promoting infringement would for all practical purposes conclusively establish the invalidity of the patent in suit and dispose of the entire controversy, thereby making it impossible for petitioner to obtain a conflicting decision in other circuits.

8. Immediately following the decision of the Circuit Court of Appeals herein all the royalty payments under the patent in suit were suspended and forgiven and the following notice was sent to all licensees:

> "On January 10, 1946 the Circuit Court of Appeals, Second Circuit, held invalid U. S. Patent No. Re. 22,397 which is one of the patents under which you are licensed.
>
> "The decision was based on a legal technicality involving a new interpretation of the law. It was not based on lack of invention or prior use by others. We believe the decision to be wrong and are taking steps to have it reversed.
>
> "The decision is binding only in the states of New York, Connecticut and Vermont, and it only affects one of the patents under which you are licensed. Nevertheless, pending a clarification of the law involved in the decision, effective January 11, 1946, all payments under your FUSE BOND license are suspended and will be forgiven until the U. S. Patent No. Re. 22,397 has been declared valid by either the Second Circuit Court of Appeals or the United States Supreme Court.
>
> "Since you have made payment in advance under your license, we are refunding the suspended and forgiven portion of your advance payment.
>
> "Keep your FUSE BOND license because it remains in force and permits you to operate under these Patents, although payments are suspended and forgiven as outlined above."
>
> REA A. AXLINE.

Sworn to before me this
28th day of May, 1946.

DOROTHY E. HUBNER
Notary Public, Queens County
Clerk's No. 1121, Reg. No. 96-H-8
Comm. expires March 30, 1948

A

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

Civ. 26-150

METALLIZING ENGINEERING CO., INC.,

Plaintiff,

against

METALLIZING COMPANY OF AMERICA, LARRY E. KUNKLER, VERNON A. COOK, IRVING BALTIMORE,

Defendants.

Preliminary Injunction

This cause came on to be heard on plaintiff's motion for a preliminary injunction and the Court having considered the verified complaint, the affidavits and attached exhibits submitted in support of the motion, and the affidavits and attached exhibits in opposition thereto, the Court makes the following:

Findings of Fact

1. The patent in suit, United States Letters Reissue Patent No. Re. 22,397 was litigated in the United States District Court for the District of Connecticut in the case of *Metallizing Engineering Co. Inc.* v. *Kenyon Bearing & Auto Parts Co. Inc. et al.*, resulting in a decree in favor of plaintiff. 65 U. S. P. Q. 344;

2. The defendants in the present case assumed and conducted the defense of that litigation in behalf of their customer, the Kenyon Bearing & Auto Parts Co. Inc. and the Kenyons individually;

3. An appeal is now pending from the decree in said Connecticut case;

4. The defendants for the purpose of advancing the sale of their Mogul electric bonder, a transformer which may be used for the purpose of preparing a metal surface for metal spraying, as well as for other purposes, have practiced the process described and claimed in plaintiff's U. S. Letters Reissue Patent No. Re. 22,397 in demonstrating to others how said transformer may be used;

5. Defendants have incited others to practice the process described and claimed in plaintiff's U. S. Reissue Patent No. Re. 22,397 by instructing them how to do so, by distributing written instructions to that end, by advising them that the said patent is invalid and should be disregarded and by advising and agreeing with purchasers of their said transformer that defendants would safeguard and indemnify purchasers of said transformer against the consequences of such infringement;

6. The defendants have failed to show misuse of the reissue patent in suit;

On the basis of the foregoing the Court makes the following:

Conclusions of Law

1. The defendants are bound by the adjudication in the said case of *Metallizing Engineering Co. Inc.* v. *Kenyon Bearing & Auto Parts Co. Inc. et al.*, and the patentability of the process of the patent in suit, U. S. Letters

Reissue Patent No. Re. 22,397 is no longer a question between the parties to this suit;

2. The pendency of the appeal from the decision in the said Kenyon case does not militate against the efficacy or binding effect thereof;

3. Defendants have directly infringed the patent in suit and should be enjoined from so doing;

4. The defendants have, contributorily and jointly with others, infringed the reissue patent in suit and should be enjoined from doing so;

Ordered

WHEREFORE it is hereby

ORDERED, ADJUDGED and DECREED that the defendants herein and each of them and those controlled by and in privity with said defendants and each of them, be and they hereby are restrained and enjoined, pending the determination of this action:

(a) from directly or indirectly practicing or causing to be practiced the process involving the improvement in the application of spray metal to metal surfaces, in accordance with or embodying any invention of the United States Letters Reissue Patent No. Re. 22,397; and from infringement upon or violating the said United States Letters Reissue Patent No. Re. 22,397 in any way whatsoever;

(b) from participating or collaborating in, instigating, aiding or abetting, directly or indirectly, the practice by others of the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Re-

issue Patent No. Re. 22,397, or otherwise violating the said Letters Reissue Patent No. Re. 22,397 in any way whatsoever;

(c) from directly or indirectly infringing the said United States Letters Reissue Patent No. Re. 22,-397

(1) by instructing any individual, firm, corporation or association in the operation of the process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(2) by themselves practicing in the course of such instruction the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(3) by disseminating, distributing or issuing to any individual, firm, corporation or association, pamphlets, advertisements, magazines, articles or any other writing inducing or tending to induce such individual, firm, corporation or association to practice the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(4) by advising any individual, firm, corporation or association or inferring to any individual, firm, corporation or association, that the said

United States Letters Reissue Patent No. Re. 22,397 is invalid and should be disregarded and may be infringed;

(5) by advising and inferring to any individual, firm, corporation or association, or promising that if they would infringe said United States Letters Reissue Patent No. Re. 22,397, the defendants would safeguard them against the consequences of infringement and would indemnify them against such consequences;

(6) by contracting with any individual, firm, corporation or association to safeguard them against the consequences of infringement of said Letters Reissue Patent No. Re. 22,397, and/or to indemnify them against the consequences of such infringement;

It is further ORDERED, ADJUDGED and DECREED that said defendants and each of them and those controlled by and in privity with said defendants and each of them, pending the determination of this action, be and the same hereby are required to give notice in writing to any and every purchaser of their Mogul transformer that the same is not to be used in the practice of plaintiff's patented process covered by U. S. Letters Reissue Patent No. Re. 22,397 except with plaintiff's written consent or license;

It is still further ORDERED, ADJUDGED and DECREED that the plaintiff first give security in the sum of Five Thousand ($5000) Dollars for the payment of such costs and damages as may be incurred or suffered by any party hereto who is found to have been wrongfully enjoined or restrained, any bond to be approved by the Court or the Clerk thereof.

JOHN BRIGHT,
Judge, United States District Court.

Dated: August 22nd, 1945.